

09/546,962

T130/TELNP202USA

REMARKS

Claims 1-6, 8-10, 12-18, 20, 21 and 23 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-6, 8-10, 12-18, 20, 21 and 23 Under 35 U.S.C. §103(a)

Claims 1-6, 8-10, 12-18, 20, 21 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brobst, *et al.* (U.S. 6,053,409) in view of Tawara (U.S. 5,710,418). This rejection should be withdrawn for at least the following reasons. The cited references, either alone or when combined, neither teach nor suggest all the claim limitations. Moreover, the references when combined render the primary reference, Brobst *et al.*, unsuitable for its intended purpose.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, **there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.** Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** See MPEP §706.02(j).

Applicant's claimed invention relates to a scanner and reader that may be economically implemented by employing a reflector having an arcuate reflective surface with a variable shape to provide a non-mechanical, low cost scanning system (*See e.g.*, pg. 3, lns. 3-9). To this end, independent claims 1, 15, 21 and 23 recite similar features namely **a beam expander with a generally cylindrical reflective outer surface and the shape controlling system selectively varying the shape of the reflector, whereby the second portion scans across at least a portion of the target.** Brobst *et al.* neither teaches nor suggests such novel aspects of varying the shape of the reflector, whereby scanning is achieved. Further, Tawara does not make up for this deficiency of Brobst *et al.*

09/546,962

T130/TELNP202USA

Brobst *et al.* relates to a dynamic focusing apparatus for increasing the depth of field of an imaging system, such as an optical scanner. According to Brobst *et al.*, a laser beam passes through an aperture and strikes a multifaceted polygonal scan mirror. As the scan mirror *rotates*, each facet produces one complete sweep of the scanning beam across the bar code labels (*See* col.3, lns. 16-17 and 26-28). Therefore, the system of Brobst *et al.* relies on the rotating/oscillating mirror to produce the scanning beam but neither teaches nor suggests *the shape controlling system selectively varying the shape of the reflector, whereby the second portion scans across at least a portion of the target*. Tawara does not teach a *shape controlling system* let alone teaching or suggesting *selectively varying the shape of the reflector, whereby the second portion scans across at least a portion of the target*, and, therefore, cannot make up for the aforementioned deficiencies of Brobst *et al.*

On page 3 of the Final Office Action dated April 7, 2006 the Examiner erroneously contends that it would have been obvious to adapt the teachings of Tawara into the system of Brobst *et al.* by adapting a cylindrical body for reflecting the scanning beam. As stated *supra* Brobst *et al.* relates to a dynamic *focusing* apparatus for increasing the depth of field of an imaging system by encompassing different focal points (*See e.g.*, col. 4, lns. 12-14, 26-28, 45-47 *etc.*). Tawara teaches an optical device such as a cylindrical mirror, cylindrical lens *etc.* for greatly expanding a beam along one axis so that the *beam cross-section would be a greatly elongated rectangle having a line-like shape*. This line beam is then projected from the reader for *encompassing and illuminating the entire width of a bar code* (*See* Abstract). If the cylindrical body of Tawara were to be used in the apparatus of Brobst *et al.* for reflecting the scanning beam, as suggested in the Final Office Action, the cross section of the reflected beam would be a greatly elongated rectangle having a line-like shape and not a focused point as disclosed by Brobst *et al.* (*See e.g.*, col. 4, lns. 12-13, 22-28, and col.5, lns. 34-36) Hence combining the references as contended in the Office Actions (dated October 25, 2005 and April 7, 2006) would render the system of Brobst *et al.* unsatisfactory as a dynamic *focusing* apparatus which increases the field of depth by encompassing different focal points. CAFC has maintained that there is no suggestion or motivation to make the proposed modification if the proposed modification would render the reference invention being modified unsatisfactory for its intended purpose. (*In re Gordon*, 733 F.2d 900, 902, 221, USPQ1125, 1127 (Fed. Cir. 1984)).

09/546,962

T130/TELNP202USA

Therefore, in view of at least the aforementioned it is clear that Brobst *et al.* and Tawara, either separately or in combination fail to render the claimed invention obvious. Hence, withdrawal of this rejection with respect to independent claims 1, 15, 21, 23 and all the claims that depend there from is respectfully requested.

In addition, the Examiner in his Response to arguments (Final OA dated April 7, 2006) has sought a showing of support in the specification for the longer lasting nature of the components of the subject invention as compared to the references. Brobst *et al.* and Tawara both employ mechanical moving parts such as a rotating mirror or a cone on a moving button (See *e.g.*, Tawara col. 5, lns. 11-17). The disadvantages of such moving elements are discussed in the Background section of Applicant's specification. The subject invention mitigates the need for such mechanical parts for scanning a barcode by utilizing a *shape controlling system selectively varying the shape of the reflector, whereby the second portion scans across at least a portion of the target.* (See *e.g.*, Applicant's disclosure page 3 lines 3-17).

09/546,962

T130/TELNP202USA

CONCLUSION

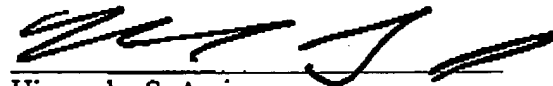
The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [TELNP202USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP



Himanshu S. Amin
Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731